

REMARKS

Applicant respectfully requests consideration of the subject application. This Response is submitted in response to the Office Action mailed December 22, 2008. Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45-46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 are pending. Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 are rejected. Claims 1, 31, 45, 54, 56, 58, 72, and 74 have been amended. No new matter has been added.

35 U.S.C. § 112 Rejections

The Examiner has rejected claims 1, 31, 45, 46, 54, 56, 58, 72, and 74 under 35 U.S.C. §112, first paragraph because the specification purportedly does not describe the limitation of “the advertisement is still displayed to the user.” Claims 1, 31, 45, 46, 54, 56, 58, 72, and 74 have been amended thus rendering the Examiner’s rejection moot.

The Examiner has rejected claims 1, 31, 45, 46, 54, 56, 58, 72, and 74 under 35 U.S.C. §112, second paragraph because the negative limitation “said World Wide Web page is not an advertisement” is purportedly indefinite. Claims 1, 31, 45, 46, 54, 56, 58, 72, and 74 have been amended thus rendering the Examiner’s rejection moot.

Accordingly, Applicants respectfully request withdrawal of the rejections of claims 1, 31, 45, 46, 54, 56, 58, 72, and 74 under 35 U.S.C. §112, first paragraph and second paragraph.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74, and 78-82 under 35 U.S.C. § 103(a) as being unpatentable over Thomas, (U.S. Patent No.: 6,128,663, hereinafter “Thomas”) in view of Official Notice.

Claims 1 is patentable at least because the cited prior art fails to teach or suggest determining an advertisement to be displayed on a World Wide Web page, wherein said

World Wide Web page includes content other than the advertisement and determining a message to be displayed on said World Wide Web page, wherein said message is thematically related to said advertisement as required by claim 1.

The Examiner asserts that “in Thomas, the banner ad is equivalent to the tailored message in the claims and the content of requested page is equivalent to the advertisement being claimed.” Office Action, page 6. However, the present claims have been amended to further define the content of the World Wide Web page as including content other than the advertisement and, as such, the content of Thomas’ requested page is clearly not equivalent to the advertisement as asserted by the Examiner and furthermore, Thomas fails to teach or suggest at least this element of claim 1.

The Examiner notes that Thomas teaches on col. 4, lines 60-65, “a particular advertising banner (tailored message) that is chosen to be transmitted with the content of requested page [advertisement] is determined, not randomly, but in accordance with the demographics identifier. Other modification could also be made such as providing a greeting, selecting an appropriate variant of the requested page or portion thereof, etc.” and asserts that Thomas “teaches the greeting message (banner) being based on demographic identifier and appropriate variant of the requested page so therefore the tailored message or banner are not chosen randomly but customized based on the demographic and user interests and variant of the requested page.” Office Action, pages 6 and 7. However, the variant pointed to by the Examiner is merely a modification of a “requested page or portion thereof” (*Thomas*, col. 4, lines 61-65) and does not relate to the determination of an advertisement to be displayed on a requested page as required by claim 1. Furthermore, even if the Examiner’s assertion regarding the teachings of Thomas were true, Thomas still fails to teach or suggest determining a message to be displayed on a World Wide Web page that is thematically related to an advertisement as required by the claim 1.

Official Notice

The Examiner has taken Official Notice of the following:

1. That it is old and well-known to receive personal information from a user such as a user's name, age and gender when a user fills out an application and the like;
2. That placing a message proximal to an ad or within the advertisement is old and well-known to bring the user's attention to the ad;
3. That it is old and well-known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed;
4. That changing display attribute within a message such as changing display color or image will bring the user's attention to the message; and
5. That it is old and well-know to serve default messages when targeting criteria hasn't been met. For example, default messages for or general messages are displayed to the customer when the customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public.

Even if the Applicants agreed with the Examiner's taking of Official Notice of the above points, they still fail to overcome the above noted deficiencies of Thomas. As such, the combination of Thomas and Official Notice fails to teach or suggest each and every element of the claim 1.

Thus, for at least these reasons, Thomas and Official Notice, whether considered alone, or in combination, fail to teach or suggest each and every element of claim 1. All the other claims rejected by the Examiner have limitations similar to those recited in claim 1 and are patentable over Thomas in view of Official Notice for at least the same reasons as claim 1. Therefore, the present claims are patentable over Thomas in view of Official Notice.

Applicant respectfully submits that the present application is in condition for allowance.

Please charge any shortages and credit any overages to Deposit Account No. 19-3140. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 19-3140.

Respectfully submitted,
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